

## REMARKS

The following remarks are in response to the Office Action mailed February 23, 2006.

### I. REJECTION UNDER 35 U.S.C. §102

Claims 1-5 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Lewis *et al.* (U.S. Patent No. 5,571,401), or in the alternative, under 35 U.S.C. §103(a) as obvious over Lewis *et al.* Applicants respectfully traverse this rejection.

The '401 patent does not teach or suggest a plurality of sensors comprising similar compositions but different thicknesses as described and claimed above. Applicants submit that the sensors resulting from the process described in claim 1 are not taught or suggested by the '401 patent.

While the Examiner admits that sensor elements 3-5 all produce different sensor responses, the Examiner concludes this **must** be due to varying film thickness. Applicants respectfully submit that the result in differing sensor responses could have been due to structural differences as the components of the film phase-separated differently during the manufacturing process, or a variety of other possibilities. Applicants respectfully bring to the attention of the Examiner the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic, *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Furthermore, "in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows from the teachings of the applied prior art."

*Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). As there are no inherent characteristics in the invention that necessarily flow from the teachings of the '401 patent, the Examiner's reliance upon "inherency" is misplaced. Accordingly, the rejection may be properly withdrawn.

## II. REJECTION UNDER 35 U.S.C. §103

Claims 1-5 stand rejected under 35 U.S.C. §103(a) as obvious over Lewis *et al.* (5,571,401). The Examiner asserts that the sensors with varying film thickness would have been obvious to one of ordinary skill in the art based on the information contained in the '401 disclosure, specifically the '401's alleged inherent teaching that resistance changes could be observed in response to an analyte depending on the thickness and chemical make up of the film. Additionally, the Examiner asserts that the '401 teaches that variability from sensor to sensor is provided by qualitatively or quantitatively varying the compositions of the region. Applicants traverse this rejection.

Applicants' invention teaches the use of identical sensor compositions with different thicknesses. The '401 patent teach the different compositions for each sensor. Thus, Applicants submit that it would not have been obvious to one of ordinary skill in the art to use the '401 disclosure and obtain the varying sensor responses as taught in the invention.

Furthermore, consideration of an inherent quality is relevant only to anticipation, not obviousness. *Jones v. Hardy*, 230 USPQ 1021, 1025 (Fed. Cir. 1984). It may not be a *per se* rule that inherency does not apply to an obviousness analysis, so much as a logical impossibility, because an inherent feature would have

to be suggested in order to contribute to a finding of obviousness. Yet if the feature were suggested, it would not be characterized as "inherent". Accordingly, the rejection may be properly withdrawn.

Respectfully submitted,

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